

### REMARKS

Applicant has reviewed and considered the Office Action mailed on February 25, 2003, and the references cited therewith. Claims 1-29 are pending in this application.

#### §102 Rejection of the Claims

Claims 1-3, 6-8, 10-11, 13-14, 16-17, 19-21, 24-25 and 27-28 were rejected under 35 USC § 102(e) as being anticipated by Williams (US 5,977,964). This rejection is respectfully traversed at least on the basis that Williams does not show each and every element of the claims.

The present invention may be utilized to determine who is present in a room that has access to a display. It uses that information to control the content that is displayed on the television screen. In contrast, Williams determines who is actually using a computer system. It does not determine who can view a display. For example, the Williams device would be ineffective in a typical scenario in which a number of users were in a position to view the display while only a single user was actually sitting at a keyboard using the computer system. Williams controls content in the context of a single user at a time, and that user's user profile that is updated corresponding "at least in part on the monitored user interaction with the system". Col. 2 lines 10-22.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation because at least one element is not shown in Williams.

Claim 1 recites “a user-recognition input device that **determines whether an additional user is newly present in a given area** having access to the display”. The Office action indicates that Williams discloses a user recognition input device in Figure 1 (118, 120), Figure 7 (706), and as described in column 11, lines 2-21. In association with such description of Williams, Williams then provides the following explanation of the functions performed by a camera and microphone: “Having determined **which user** of a plurality of entertainment system users is currently using system 10, system controller 104, in one embodiment, **presents the user** with a number of programming suggestions which most closely align with the user profile of the **particular user...**” Col. 11, lines 22-26 (emphasis added). Thus, Williams is directed toward interfacing with a single user at a time, and recognizing the single user. Claim 1 is directed toward determining whether an additional user is newly present in a given area and controlling display of information based on that determination.

Williams does not provide the function of detecting users in a given area, only “which user is currently using the system”. This does not teach “determining if an additional user is newly present in a given area having access to the display”. Still further, it does not control the display of information based on who is in a given area, such as a room where one can see the display. Williams only controls based on which user is “currently using” the system. Per the Summary in Williams, “currently using” requires “system interaction” which can be monitored. The presently claimed invention only requires presence within an area.

Williams does not detect additional users. Further, recognition is triggered when “the user speaks into a microphone of system 100 (e.g., to activate system 100).” Col. 11, lines 2-4. Williams does not determine if an additional user is newly present, only “which user is currently using the system”. There is no concept of an additional user, only a new user. Clearly another user could be present, but if they are not using the system, they are not detected by Williams, and there is no restriction on the information being displayed based on the another user.

The rejection of claim 1 does not address the functions performed that are clearly recited with each element. Functional language is specifically authorized by *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971); *In re Caldwell*, 138 USPQ 243 (CCPA 1963); *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987); MPEP §

2173.05(g). As such, a prima facie case of anticipation has not been established.

Claim 2 depends from claim 1, and is patentable for at least the same reasons. Further, the characterization of Figure 2 containing (NEW USERS DETECTED?) is respectfully traversed. USERS is not plural in Figure 2. The correct phrase is (NEW USER DETECTED?). This further supports applicant's reading of Williams as only dealing with one user at a time, and not an additional user. Claims 3-6 also depend from claim 1, and distinguish Williams for at least the same reasons.

Independent claim 7 recites: "a user-recognition device that determines which users are present in a given area". As indicated with respect to claim 1, Williams only determines which user is currently user the system. It does not determine the identities of multiple users as claimed in claim 1, only the single "current user". This temporal aspects of current user cannot be ignored. Other potential users may be near enough to see the display, but they are clearly not detected by Williams. It is not proper to equate "current user" and implied next user to "which users are present in a given area". Hence, a prima facie case of anticipation has not been established, and the rejection should be withdrawn.

Claims 8-12 depend from claim 7 and distinguish from Williams for at least the same reasons.

Independent claim 13 refers to "determining that a user is present in a given area having access to the display of video information". As previously referenced, Williams does not determine whether a user is in a certain area. Hence, a prima facie case of anticipation has not been established, and the rejection should be withdrawn.

Claims 14-18 depend from claim 13 and distinguish for at least the same reasons.

Claim 19 contains language similar to that in claim 1: "determining that an additional user is newly present in a given area having access to the output information". Williams clearly only determines the identity of a current user, not whether an additional user is newly present in a given area having access. Thus, a prima facie case of anticipation has not been established, and the rejection should be withdrawn.

Claims 20-21 depend from claim 19 and distinguish for at least the same reasons.

Independent claim 24 contains much functional language that has not been addressed in

the Office Action. Claim 24 refers to “determining which users are present in a given area”, “which users are permitted access to that content”, and “selectively blocking display of the content based on the access-allowed indication.” Williams is not cited as containing apparatus performing any of these functions. Hence, a *prima facie* case of anticipation has not been established, and the rejection should be withdrawn.

Claims 25-29 depend from claim 24 and distinguish for at least the same reasons.

§103 Rejection of the Claims

Claims 4, 12, 18, 22 and 29 were rejected under 35 USC § 103(a) as being unpatentable over Williams (US 5,977,964) in view of Lu (US 5,771,307). The rejection is respectfully traversed.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for the following reasons:

(1) Even if combined, the cited references fail to teach or suggest all of the elements of applicant's claimed invention. The remarks with respect to the §102 rejection of these claims establish several elements that are lacking in Williams. Lu is not represented in the Office Action as providing them. Thus, a *prima facie* case of obviousness has not been established, and the rejection should be withdrawn.

(2) Evidence for a suggestion to combine is not of record. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). The Office Action stated "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Williams to include a motion sensor, as disclosed by Lu, to increase reliability, and accuracy of viewer detection when viewers enter or leave the viewing area." which is a mere conclusory statement of subjective belief, so Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references. Since Williams is only concerned with the current user, it would not make sense to modify Williams to detect other users. No functions in Williams would

be served by such modification. Williams expresses no concept of entering or leaving a "viewing area", only detection of a current user.

Claims 5 and 23 were rejected under 35 USC § 103(a) as being unpatentable over Williams (US 5,977,964) in view of Wachob (US 5,231,494). This rejection is respectfully traversed.

The remarks with respect to the §102 rejection of these claims establish several elements that are lacking in Williams. Wachob is not represented in the Office Action as providing them. Thus, a prima facie case of obviousness has not been established, and the rejection should be withdrawn. Further, there is no objective evidence of record for a suggestion to combine Williams and Wachob.

Claims 9, 15 and 26 were rejected under 35 USC § 103(a) as being unpatentable over Williams (US 5,977,964) in view of Kipust (US 6,002,427). This rejection is respectfully traversed.

The remarks with respect to the §102 rejection of these claims establish several elements that are lacking in Williams. Kipust is not represented in the Office Action as providing them. Thus, a prima facie case of obviousness has not been established, and the rejection should be withdrawn. Further, there is no objective evidence of record for a suggestion to combine Williams and Kipust.

AMENDMENT AND RESPONSE UNDER 37 CFR 1.111

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6972) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 22 day of April, 2003.

**Candis B. Buending**

Name

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